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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,582	12/22/2003	James A. Euchner	F-629	1581

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PITNEY BOWES INC.  
35 WATERVIEW DRIVE  
P.O. BOX 3000  
MSC 26-22  
SHELTON, CT 06484-8000

EXAMINER

FABER, DAVID

ART UNIT PAPER NUMBER

2178

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/707,582	EUCHNER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David Faber	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/23/03, 8/4/04, 7/5/05, 7/8/05</u>                                      | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This office action is in response to the application filed 22 December 2003.

**This action is made Non-Final.**

2. Claims 1-20 are pending. Claims 1, and 13 are independent claims.

### ***Information Disclosure Statement***

3. The information disclosure statements (IDS) submitted on 22 December 2003, 4 August 2004, 5 July 2005, and 8 July 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

4. The drawings filed on 22 December 2003 are accepted.

### ***Claim Objections***

5. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims [c1]-[c20] been renumbered 1-20.

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6. Applicant is advised that should claim 5 be found allowable, claim 6 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 10 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 10 and 20 recites the word "nonpriority" which is vague and indefinite. The use of the word is not stated in the specification and is not defined in any dictionary.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kardach (US PG Pub 20030001020, filed 6/27/2001).

As per independent Claim 1, Kardach discloses a method comprising:

- obtaining an original document; (Paragraph 0029; FIG 2, Discloses using a calendar application to print out a hardcopy of the calendar. A user obtains an original document by creating a new calendar document within the calendar application.)
- making an original electronic version of the document available to an annotation manager system; (FIG 5 and 6, Paragraph 0033 – 0035; Comprises a computer system that contains the electronic application containing the electronic version of the document and a wireless component that receives information from the digital pen when the pen is used to read the ID on the page or used to make edits on the digital paper.)
- associating the original electronic version of the document with digital paper; (Paragraph 0019 – Discloses the printed hardcopy representation of an electronic application on a paper that has a printed pattern with an Anoto pattern consisting of a pattern of dots. Applicant discloses in the specification in Paragraph 0025 that the dotted pattern by Anoto is Anoto digital paper.)
- associating each annotation with a location in the original electronic version of the document; and (FIG. 1, 103-104, The updates are sent to the computer

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system that has the electronic document corresponding to the hardcopy representation, and updates the document based on the edits automatically.)

- creating a new annotated version of the original electronic version of the document incorporating the annotations. (FIG. 1, 104; The electronic document is updated with the edits (annotations), thus a new version is created.)

However Kardach fail to specifically disclose printing a "plurality" of hardcopies of the original electronic version of the document on the associated digital paper, distributing the hardcopies to a plurality of team members, and receiving a plurality of annotations from the team members. However, Kardach discloses the use of a calendar application used to print out a hardcopy representation of a calendar on the Anoto digital paper. Since it is well established that meetings generally involve calendar scheduling of all involved parties, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have printed multiple hardcopies of Kardach's calendar for purpose of scheduling meetings and distribute said hardcopies among of company workers (e.g. lawyers, executives etc.) to edit the calendar blocks on the paper that indicate the availability of each worker, and for submission to the distributor. The distributor receives all the edited hardcopies and schedule meetings based on the received information.

It would have been obvious to one of ordinary skill in the art at the time of applicants invention to have combined Kardach's method with the method disclose

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above would have provided the benefit of scheduling for those without a network or a computer system.

As per Claim 11, Claim 11 discloses similar limitations recited as in Claim 1, and is rejected under rationale. Furthermore, Kardach discloses a method:

- the associating the original electronic version of the document with digital paper further comprises scanning a digital pattern on the digital paper before printing a plurality of hardcopies. (Paragraph 0034 – Kardach discloses using a pen to draw a line over an ID icon that reads the ID pattern, and paper pattern wherein having the ID pattern location be associated with the printed application, while paper pattern be associated with a blank page function.

When the pen recognizes a pen stroke between the two patterns, the paper pattern is associated with the meaning assigned it via by the ID pattern. Thus, when the paper application is printed, the computer will have stored paper pattern information associated with the functions to be performed.)

As per independent Claim 13, the applicant recites a system for performing the method of Claim 1. Therefore, Claim 13 is similarly rejected under Kardach.

12. Claims 2-4, 12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kardach (US PG Pub 20030001020, filed 6/27/2001) in further view of Kuruoglu et al (PG Pub 20020078088, published 6/20/2002).

As per dependent Claims 2-4, Kardach fails to specifically disclose the method further comprising incorporating annotation metadata into new annotation version,

wherein the metadata includes a time and date associated with each annotation, and includes a user identification for each association. However, Kuruoglu et al discloses that each annotation is stored in the form of an object wherein comprises a document identifier, a location identifier, a time stamp indicating time and date the annotation was detected, and author identifier identifying the author of the annotation. (FIG 3; Paragraph 0032)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Kardach's method with Kuruoglu et al method since Kuruoglu et al's method would have allowed the annotations to be independently manipulated by being separated into objects.

As per Claim 12, Kardach and Kuruoglu et al fail to disclose comparing the annotation time metadata against a reviewer profile. However, Kuruoglu discloses that users work collaboratively on a document through a collaborative annotation system comprising a server communicating with a plurality of workstations. (Abstract, lines 1-7) It was well-known to one of ordinary skill that a network contained a database consisting of user profiles allowing only those users listed to be able to login into the corresponding system. When users logged In into a workstation, its time of entry, usage, and time of logging out is transmitted and recorded in the profile within the database. Thus, Kuruoglu et al discloses annotation objects containing time metadata (Paragraph 0032) wherein the administrator of the collaborative system has the ability to compare the time metadata against the information in the user's profile within the system's database.



It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Kardach's method with Kuruoglu et al method since Kuruoglu et al's method would have allowed the annotations to be independently manipulated by being separated into objects.

As per dependent Claim 14, the applicant recites a system for performing the method of Claim 2. Therefore, Claim 14 is similarly rejected under Kardach and Kuruoglu et al.

As per dependent Claim 15, the applicant recites a system for performing the method of Claim 3. Therefore, Claim 15 is similarly rejected under Kardach and Kuruoglu et al.

As per dependent Claim 16, the applicant recites a system for performing the method of Claim 4. Therefore, Claim 16 is similarly rejected under Kardach and Kuruoglu et al.

13. Claims 5-6, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kardach (US PG Pub 20030001020, filed 6/27/2001) in further view of Barger et al (PG Pub 20040205545, filed 4/10/2002).

As per dependent Claims 5 and 6, Kardach discloses that the electronic document is updated with the edits transmitted to the computer system, (Fig 1, 103-104) but Kardach fails to specifically disclose the anchoring at least one of the annotations to a paragraph of the original electronic version of the document. However, Barger et al

discloses a content anchor that includes a position field that identifies where the annotation occurs in the article. (Paragraph 0035, lines 8-13)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Kardach's method with Barger et al method since Barger et al's method would have allowed applications to support annotations and further extend the basic framework by adding new properties, objects, methods, etc. as they desired.

As per dependent Claim 17, the applicant recites a system for performing the method of Claim 5. Therefore, Claim 17 is similarly rejected under Kardach and Ericson et al.

14. Claims 7, 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kardach (US PG Pub 20030001020, filed 6/27/2001) in further view of Ericson et al (PG Pub 20040205545, filed 4/10/2002).

As per dependent Claims 7, and 9, Kardach fails to specifically disclose parsing the annotations for at least one editing commands, in which at least one of the editing commands is a plurality of editing commands, and including prioritizing the editing commands. However, Ericson et al discloses recognizing a plurality of editing symbols, parsing each of the symbols, and prioritizing the symbols by interpreting each symbol in a specific order into an editing command to occur when annotating the document. (FIG 5(a-c); Paragraphs 0070-73)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Kardach's method with Ericson et al method since Ericson et al's method would have allowed a user to view edits in hard copy on the very surface that is used to electronically input those changes.

As per dependent Claim 18, the applicant recites a system for performing the method of Claim 7. Therefore, Claim 18 is similarly rejected under Kardach and Ericson et al.

15. Claims 8, 10, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kardach (US PG Pub 20030001020, filed 6/27/2001) in further view of Ericson et al (PG Pub 20040205545, filed 4/10/2002) in further view of Anderson et al (US Patent #5,581,682, patented 12/3/1996).

As per dependent Claims 8, and 10, Kardach fails to specifically disclose converting nonpriority editing commands into annotations. However, Ericson et al discloses recognizing a plurality of editing symbols, and converting each of the editing symbols by interpreting each symbol in a specific order into an editing command to occur when annotating the document. (FIG 5(a-c); Paragraphs 0070-73)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Kardach's method with Ericson et al method since Ericson et al's method would have allowed a user to view edits in hard copy on the very surface that is used to electronically input those changes.

In addition, Kardach and Ericson et al fail to specifically disclose determining an authorization level for the at least one editing command, and if the authorization level for the at least one editing command is below an authorization threshold, converting the at least one editing command into an annotation. However, Anderson et al discloses a system that examines a security level of the redaction, a form of annotation, and compares it to the security level of the user in which if the security level exceeds that of the user, then the user is unauthorized to view the document prior to redaction, while, on the other hand, does not exceed the security level, then redaction is not applied. (Column 5, lines 3-14)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined Kardach's and Ericson et al's method with Anderson et al method with editing commands instead of a user since Anderson et al's method would have allowed documents containing text, graphics, and images to be annotated or redacted by other objects carried in the same data stream without compromising the integrity of the original document.

As per dependent Claim 19, the applicant recites a system for performing the method of Claim 8. Therefore, Claim 19 is similarly rejected under Kardach, Ericson et al, and Anderson et al.

As per dependent Claim 20, the applicant recites a system for performing the method of Claim 10. Therefore, Claim 20 is similarly rejected under Kardach, Ericson et al, and Anderson et al.

***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mahoney et al (US Patent #6,865,284): Discloses a method for processing an electronic version of a hardcopy of a document.
- Stumbo et al (US PGPub 20040139391): Discloses integration of handwritten annotations into an electronic original.
- Henderson (US Patent #5,897,648): Discloses editing electronic documents using a digital pen on a hardcopy of the original document.
- Guimbretiere, Paper Augmented Digital Documents, SIGCHI 2003, November 2-5, 2003, pp 51-60 : Discloses information relating to digital documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

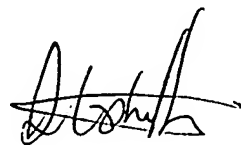
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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David Faber  
Patent Examiner  
Art Unit 2178



**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**